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May 26, 2004
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Loring Coat Co.
v.
Estevan Poveda, Pedro and
Estevan Poveda, Emillio

_____

Cancellation No. 92029831

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Myron Amer of Myron Amer, P.C. for Loring Coat Co.

Mark I. Peroff, Manjari M. Datta and Darren W. Saunders of Trademark & Patent Counselors of America, P.C. for Pedro Estevan Poveda and Emillio Estevan Poveda.

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Before Simms, Hohein and Drost, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Loring Coat Co. has petitioned to cancel the registration, as originally issued to Pedro Estevan Poveda and Emillio Estevan Poveda, of the mark "SKIPPER" for "clothing for men, women, and children, namely, shirts, trousers, jackets, sweaters, shorts, belts, suits, vests, coats, skirts, blouses, scarves, ties, socks, track suits, jerseys, hats, and footwear."[1] As grounds for cancellation, petitioner alleges that it provides

[1] Reg. No. 2,181,777, issued on August 18, 1998 from an application filed on September 13, 1996, based on ownership of Spanish Reg. No. 9342257 dated March 20, 1981.

and sells men's overcoats under the mark "P.J. SKIPPER"; that it has filed application Ser. No. 75519006 to register such mark for such goods; that the application to register its mark for men's overcoats "has been refused as likely to cause confusion, or to cause mistake, or to deceive, in view of registrant's [sic] ... registration No. 2,181,777"; that upon information and belief, respondents have "abandoned" their registered mark by "discontinuing use of said mark with no intent to resume ... use [thereof]"; and that petitioner "is likely to be damaged by continuance on the register of said registration No. 2,181,777 as petitioner presently uses the mark P.J. SKIPPER for 'men's overcoats' and petitioner's ability to obtain its own registration of this mark is being impaired and the continuance of petitioner's legal use of said mark will be damaged by the continued registration of said abandoned mark of registrant[s]."

Respondents, in their answer to the petition to cancel, have basically denied the salient allegations thereof. Respondents have also affirmatively alleged therein that they "have not abandoned the trademark SKIPPER in the USA" and that:

> Petitioner's ... Application Serial No. 75/519,006 has been abandoned for failure to file a response to an office action issued on June 29, 1999 as is reported in the TARR and TESS records displayed in the U.S. Patent and Trademark website (see Exhibit "A"). The response to said office action was due on December 29, 1999. TARR and TESS does [sic] not reflect that the Petitioner has made any effort to revive said abandoned application. Petitioner had based its Petition for Cancellation on this abandoned trademark

> application. Accordingly, Petitioner has no standing to bring the subject action.

During the course of this proceeding, the parties filed a stipulated motion for withdrawal of the petition to cancel, contingent upon entry of a consented amendment to respondents' registration to limit the goods set forth therein to "footwear." Such motion, in particular, states that:

> Petitioner and Joint Registrants have entered into an Agreement which provides, *inter alia*, that pending ... amendment to the registration for SKIPPER, Petitioner will withdraw its petition for cancellation with prejudice. Therefore, it is ... requested that the Board suspend this proceeding until it has had an opportunity to consider the above request to amend the identification of goods.

The Board, in view thereof, subsequently issued an order which, among other things, accepted the consented amendment to the involved registration and allowed petitioner time to file a withdrawal of the petition to cancel, failing which this proceeding would go forward on the registration as amended. While the involved registration has, in due course, been amended so as to limit the goods set forth therein to "footwear" as agreed to by the parties, no withdrawal or other response to the Board's order was received from petitioner. Accordingly, and since trial and initial briefing had been concluded, the Board issued an order resuming proceedings and resetting due dates for filing respondents' brief on the case and petitioner's reply brief.

The record consists of the pleadings; the file of the involved registration; and the notice of reliance timely filed by

petitioner during its initial testimony period on (i) a copy of the filing receipt issued by the U.S. Patent & Trademark Office on July 15, 1998 in connection with an intent-to-use application, Ser. No. 75519006, filed by "LORING COAT CO., INC." for the mark "P.J.SKIPPER" for (as listed on the receipt) "OUTERWEAR, NAMELY LADIES', MEN'S AND CHILDRENS"[2] and (ii) respondents' answers to petitioner's Requests for Admissions Nos. 1 through 4.[3] Neither party, however, took testimony or submitted any other evidence.[4] Only petitioner filed a brief, and neither party requested an oral hearing.

Section 45 of the Trademark Act, 15 U.S.C. §1127, defines abandonment of a mark in relevant part as follows:

> *Abandonment of mark*. A mark shall be deemed to be "abandoned" when ... the following occurs:
>
> > (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for three consecutive years shall be prima facie evidence of abandonment. "Use" of a

[2] Petitioner asserts, in its notice of reliance, that "[t]he foregoing exhibit is relevant to establishing use, dating from at least July 15, 1998, by petitioner of the mark P.J. SKIPPER for the goods recited therein."

[3] Petitioner contends, in its notice of reliance, that "[t]he foregoing exhibit is relevant to establishing that registrants did not export for resale in the United States any SKIPPER-identified 'clothing for men, women and children' starting in the year 1998 and continuous to January 1, 2001.

[4] It is pointed out that respondents' Exhibit "A," which is attached to the answer, forms no part of the record herein inasmuch as Trademark Rule 2.122(c) provides, in relevant part, that "an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony." Respondents, as noted above, did not take testimony or submit any other evidence at trial.

> mark means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in the mark.

However, as indicated by our principal reviewing court in Imperial Tobacco Ltd. v. Philip Morris Inc., 899 F.2d 1575, 14 USPQ2d 1390, 1392 (Fed. Cir. 1990), in determining whether there has been an abandonment of mark where the registration thereof was obtained on the basis of a foreign registration and no use has been made of the mark in the United States from the date of registration, the earliest date from which the period necessary to establish a prima facie case of abandonment can be measured is the date of issuance of the registration sought to be cancelled.

Respondents' answers to petitioner's Requests for Admission Nos. 1 through 4 respectively state that, for the years 1998, 1999 and 2000 and for the period from January 1, 2001 to June 14, 2001,[5] "[r]egistrants admit that they did not export for resale in the United States ... any SKIPPER-identified 'clothing for men, women and children" during the time periods in question. Respondents further state, in each instance, that "[r]espondents deny that they have abandoned their trademark and that their response to this admission is *a fortiori* evidence of abandonment." In view thereof, and since the involved registration shows that respondents are Spanish citizens whose addresses are in Spain, petitioner argues in its brief that:

[5] In particular, petitioner's Request for Admission No. 4 states that "Registrant did not export for resale in the United States in the time interval from January 1, 2001 to date any SKIPPER-identified 'clothing for men, women and children.'" Respondents answered such request, as well as petitioner's other requests for admission, on June 14, 2001.

> Petitioner's position is that the mere assertion of denial, unsubstantiated by testimony proffered under oath, does not refute petitioner's contention that abandonment has been proved. Registrants are located in Spain and logic dictates that to engage in trade using the mark SKIPPER there must be SKIPPER-identified goods exported for resale into the United States. It is admitted that no such business activity has occurred and, most significant, it has been admitted not to have occurred for more than three years.
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> The time interval of more than three years is critical because 15 U.S.C. Section 1127 provides that "Nonuse for 3 consecutive years shall be prima facie evidence of abandonment". Thus, there is a presumption of abandonment which registrants have not rebutted.

We disagree with petitioner that the evidence of record introduced at trial by its notice of reliance demonstrates that respondents did not export for resale in the United States any clothing for men, women and children which was identified by the mark SKIPPER for a period of three years or more. Specifically, respondents' registration, as indicated previously, issued on August 18, 1998 based upon ownership of a Spanish registration and there is no proof that respondents have ever commenced use of such mark in the United States. Thus, as measured from the August 18, 1998 date of issuance of the involved registration, respondents arguably have admitted nonuse in the United States of the mark "SKIPPER" only for a period extending until June 14, 2001, which is just over two months short of a three-year period of nonuse necessary to demonstrate a prima facie case of abandonment of the mark for the goods set forth in such

registration. Petitioner, therefore, has failed to prove abandonment.

We need not decide, in view thereof, whether petitioner has also proven the remaining necessary element of its case-in-chief, namely, its standing to bring the petition to cancel. Given the failure by petitioner, as the party who bears the burden of proof in this proceeding, to present evidence which supports the allegation, which respondents have denied, of abandonment, it is adjudged that the petition to cancel must fail in any event.

Decision: The petition to cancel is denied.